

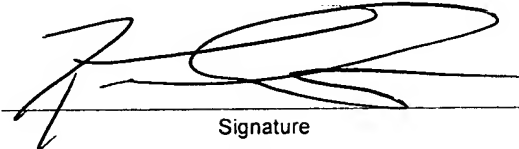


Doc Code: AP-PTO-REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

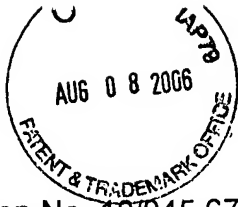
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		10/045,672	October 22, 2001
		First Named Inventor	
		Paul G. Allen	
		Art Unit	Examiner
		2145	Minh Chau Nguyen
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 43,548</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p> Signature</p> <p>Kory D. Christensen Typed or printed name</p> <p>(801) 328-3131 Telephone number</p> <p>August 8, 2006 Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input type="checkbox"/> *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Application No. 10/045,672

Docket No. 50588/49
Digeo Ref. 231

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Clear errors in fact have been made and essential elements required to establish a *prima facie* rejection are missing. In the Office Action mailed April 24, 2006 ("Office Action"), claims 1, 2, 15, 16, 21, 22, 35, 36, 41, 42, 45, and 48 were rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, and claims 1-17, 19-37, and 39-46 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 6,055,314 to Spies et al. ("Spies") and U.S. Pat. Pub. No. 2003/0023691 by Knauerhase ("Knauerhase").

1. The claims particularly point out and distinctly claim, *inter alia*, forwarding a video communication request from a broadcast center.

On page 2 of the Office Action, the Examiner alleges that the phrases "forwarding the video communication request from the broadcast center to the first selected communication device" and "forwarding the video communication request to the second selected communication device" are unclear and vague. However, Applicants respectfully disagree and assert that each independent claim or group of independent and dependent claims, when considered as a whole, provide meaning to the above phrases such that the claims particularly point out and distinctly claim the subject matter which the Applicants regard as their invention.

As discussed on page 16 of the Amendment filed March 8, 2006 ("Amendment"), an aspect of certain claims of the present invention is the ability to use a broadcast center to forward video communication requests. In addition to receiving and forwarding video calls, the broadcast center is capable of receiving programming from content providers and packaging the programming together for transmission, for example, to customers' homes. Using such a broadcast center to route video calls allows video calls to be forwarded to, for example, interactive televisions or other devices in communication with the broadcast center.

Claim 1, as it currently stands in the application, includes, among other things:

A method for **routing video calls**...comprising: receiving a video communication request **at a broadcast center** configured to distribute

programming content from content providers...selecting from the set of communication devices a first communication device...and ***forwarding the video communication request from the broadcast center*** to the first selected communication device.

In clear and simple language, claim 1 particularly points out a method for routing video calls by receiving a video communication request at a broadcast center and forwarding the video communication request from the broadcast center to a selected communication device. Independent claims 21 and 41 have similar, clearly defined, limitations. In some embodiments, if the call is not answered using the first device, the call is forwarded to a second device. For example, claim 2 further recites, among other things, "in response to the recipient not accepting the request within an established time interval: selecting a second communication device...and forwarding the video communication request to the second selected communication device." See also, claim 22. Applicant asserts that the limitations in claims 2 and 22 are clear and easily understood.

For the above reasons, the Examiner's rejection of claims 1, 2, 21, 22 and 41 under 35 U.S.C. § 112 is clearly improper and should be withdrawn. Further, claims 16, 36, 42 and 45 do not include or make reference to the phrases cited by the Examiner as allegedly being unclear and vague. For example, claims 42 and 45 are both independent claims that do not include the limitations in the cited phrases. Because the Examiner has not provided a basis for rejecting claims 16, 36, 42, and 45 under 35 U.S.C. § 112, the rejection of these claims is clearly improper and should be withdrawn.

The Examiner also rejected claim 48 under 35 U.S.C. § 112. However, there is not, nor has there ever been, a claim 48 pending in the application. Applicants suspect that this is a typographical error and that the Examiner may have intended to reject independent claim 46 rather than claim 48. However, as with claims 42 and 45 discussed above, claim 46 does not include or reference the phrases cited by the Examiner as allegedly being unclear and vague.

2. Claims 15 and 35 are clearly not in conflict with claims 1 and 21.

On pages 2 and 3 of the Office Action, the Examiner alleges that the phrases "audio only communication" and "establishing an audio-only connection" in claims 15 and 35 conflict with "video communication" recited in claims 1 and 21. However,

Applicants respectfully disagree and assert that a careful reading of the claims shows that there clearly is not a conflict between the claims.

A caller's device may be capable of providing both audio and video communication while the recipient's device is capable of providing audio-only communication. In such a case, the caller may **request** a video communication, but will only be able to establish an audio communication.

Claim 1 recites, among other things, "receiving a video communication **request**... and forwarding the video communication request...to the first selected communication device." Claim 15, which indirectly depends from claim 1, further recites "wherein the video communication request originates from a **caller device capable of audio and video** communication...detecting that **the first selected communication device supports audio-only** communication; and establishing an audio-only connection with the first selected communication device."

Claims 1 and 15, when read together, clearly indicate that there is not a conflict between the language of the claims. Claims 21 and 35 include similar limitations. Thus, a careful reading of claims 1, 15, 21 and 35 show that the claims particularly point out and distinctly claim the subject matter which Applicants regard as their invention and that the rejection under 35 U.S.C. § 112 should be withdrawn.

3. The cited references clearly do not teach or suggest receiving a video communication request at a broadcast center and forwarding the request from the broadcast center to a selected communication device associated with a recipient.

As discussed in detail above and on pages 16 and 17 of the Amendment, independent claims 1, 21 and 41 include **routing video calls** using a **broadcast center** to forward **video communication requests** to a selected communication device associated with a recipient. The broadcast center is also capable of receiving programming (e.g., television programs) from content providers for delivery to customers' homes. Routing video calls using a broadcast center advantageously allows video call requests to be forwarded to, for example, a set-top box or interactive television.

Spies, on the other hand, is *completely unrelated to call routing*. Rather, Spies teaches a method for secure purchase and delivery of video content from a video content provider. See, Spies, col. 4, line 55 to col. 5, line 7. According to page 3 of the

Office Action, Spies teaches that a “video merchant receives a request for a video content program from the purchaser [who] presents an IC card 50 to the video merchant for a selected video content program.” However, such a request for video *content* is completely unrelated to “routing video calls” by “receiving a video communication request at a broadcast center..., the video request addressed to a recipient,” as recited, among other things, in claim 1. One skilled in the art can easily see that a video purchaser’s request for video content is not the same as a caller’s **video communication request addressed to a recipient**.

On pages 3 and 4 of the Office Action, the Examiner attempts to conform the teachings of Spies with the plain language of claim 1 by stating that after receiving the purchaser’s request discussed above, “the video content provider supplies the video content program on a distribution medium by receiving the request which is addressed to the purchaser from the video merchant.” However, the portions of Spies referenced by the Examiner do not provide any support for the assertion that a request is addressed to the purchaser. Further, Applicants have found no support in Spies for such an assertion. Regardless of the addressee, Applicants respectfully submit that a request sent from a purchaser to a merchant, wherein the request is forwarded to a video content provider for the purpose of purchasing video content, as suggested by the Examiner, is not a method for **routing video calls** to a user of multiple communication devices, as required by claim 1.

Further, Spies does not teach or suggest “forwarding the video communication request from the broadcast center to the first selected communication device,” as recited in claim 1. Indeed, on page 2 of the Office Action, the Examiner admits to interpreting this element of claim 1 to mean “forwarding the resulting [or] requested video (or the video content) to the first or second communication device.” As discussed above, this is clearly an erroneous interpretation of claim 1, when considered as a whole. Again, the claims are directed to routing video calls, not to requesting video content to be downloaded or otherwise purchased from a content provider.

Knauerhase teaches routing messages to one or more a recipient device over one or more communication channels based on presence information. See, Knauerhase, paragraphs [0012] - [0014]. However, Knauerhase is silent as to using a

broadcast center to route messages. Further, the Examiner has made no argument that Knauerhase teaches or suggests using a broadcast center to route messages. Thus, neither Spies nor Knauerhase, either alone or if combined, teach or suggest using a broadcast center to route video calls. Thus, for at least this reason, the rejection of claim 1 is clearly in error and should be withdrawn. Further, independent claims 21 and 41 also include limitations similar to claim 1. Thus, the rejection of claims 21 and 41 should also be withdrawn.

4. The cited references clearly do not teach or suggest routing video calls.

As discussed above, Spies does not teach or suggest routing ***any*** calls. Further, Knauerhase does not teach or suggest routing ***video*** calls. Rather, Knauerhase merely teaches routing text messages using e-mail, instant messaging (IM), pager or fax, and voice messages using a landline telephone or cellular telephone. However, Knauerhase does not teach or suggest any type of video message routing. Further, the Examiner does not make such an assertion. Thus, the rejection of independent claims 1, 21, 41, 42, 45 and 46 is clearly erroneous and should be withdrawn.

5. Spies and Knauerhase cannot be combined.

According to page 5 of the Office Action, an artisan would have been motivated to combine Knauerhase's teachings of selecting a communication device having a high probability of being presently accessible to a recipient with Spies' teachings of providing secure purchase and delivery of video content. However, because Spies does not teach call forwarding and the purchaser in Spies makes the request himself, determining accessibility is not required or suggested. Therefore, the Examiner appears to have impermissibly used hindsight derived from the teachings of the present application, rather than the teachings of the prior art, to combine the references.

6. Conclusion

Based at least on the foregoing, claims 1, 21, 41, 42, 45 and 46 are allowable over the art that has been cited and applied by the Examiner. Further, claims 2-17, 19-20, 22-37, 39-40, and 43-44, are also allowable as depending from claims 1, 21, 41, 42, 45 and 46, respectively. Applicants therefore request withdrawal of the rejections and allowance of the application at an early date.